REMARKS

The last Office Action has been carefully considered.

After carefully considering the Examiner's grounds for the rejection of the claims based on double patenting of the same invention, applicants canceled claims 14 and 15 without prejudice.

Turning now to the Examiner's rejection of the claims over the art, it is respectfully submitted that in the present application claim 1 defines a method of painting a surface in a predetermined color, claim 9 defines a paint for painting a surface in a predetermined color, and claim 24 defines a method of producing a paint for painting a surface in a predetermined color, wherein the paint has a fume-forming binder component for forming a film of the paint on the surface, a color-producing component for providing the predetermined color on the surface, and a fire-retardant component adapted to protect the surface from consequences of fire, with the fire-retardant component which does not exceed 15 weight % of the paint and so that when a surface is painted with the paint, the predetermined color is imparted to the surface and the surface is protected from fire.

Turning now to the reference and in particular to the patent to Wainwright, it can be seen that this reference relates into intumescent compositions to form intumescent coatings for thermal protection, flame retardation, and/or smoke suppression. The reference does not disclose a method of painting, a paint, and a method of manufacturing a paint with the features which are defined in the above mentioned claims, since intumescent coatings actually are not paints.

The Examiner rejected the claims over this reference under 35 U.S.C. 102(b). In connection with this, it is believed to be advisable to cite the decision in re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

> "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Wainwright does not disclose each and every element of the present invention as now defined in the above mentioned claims 1, 9 and 24 and therefore, the anticipation rejection should be considered as not tenable and should be withdrawn.

As for the obviousness rejection applied by the Examiner, it is believed to be clear that the reference does not disclose any hint or

suggestion to make the invention obvious. In order to arrive at the present invention from the teaching of the reference, the reference has to be fundamentally modified, and in particular, by including into it the new features of the present invention which are now defined in claims 1, 9 and 24, by converting the intumescent composition disclosed in the patent to Wainwright into the paint of the present invention. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

> Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In the above presented remarks and amendments, it is believed that claims 1, 9 and 24 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the independent claims, they share their presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,

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